



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,219	04/05/2001	William Michael Bondy	CE08311R	6206

22917 7590 12/28/2004

MOTOROLA, INC.
1303 EAST ALGONQUIN ROAD
IL01/3RD
SCHAUMBURG, IL 60196

EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/827,219	BONDY ET AL.	
	Examiner	Art Unit	
	Ovidio Escalante	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 6-9 and 11-15 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 16-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2645

DETAILED ACTION

1. This action is in response to applicant's amendment filed on July 13, 2004. **Claims 1-9,11-29** are now pending in the present application.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: there is no signature for Timothy L. Moran. The petition received on October 25, 2001 was dismissed per the letter sent from the US Patent Office on December 6, 2001. A new oath or declaration adding the signature has not yet been received.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1,3-5,16,18-20,22-24,26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dikmen US Patent 6,549,613 in view of Kung et al. US Patent 6,553,025.

Regarding claim 1, Dikmen teaches a method for providing surveillance within a communication network, (abstract), the communication network providing communication services for a subscriber, (col. 1, line 43 - col. 2, line 2), wherein the subscriber accesses the communication network via an access network, (col. 3, lines 5-34), the method comprising the steps of:

receiving a request for surveillance services from a requesting agency, (col. 3, line 60-63; subscribers that are lawfully authorized for initiating electronic surveillance will have a trigger in the network that will be initiated when a trigger event occurs);

receiving trigger information associated with surveillance services in response to a trigger event, (col. 3, line 60-col. 4, line 4);

generating a duplicate of call information associated with a surveillance target in response to the trigger information, (col. 3, lines 18-22); and

transmitting the duplicate of call information to the requesting agency, (col. 3, lines 18-34; col. 4, lines 62-67).

Dikmen further teaches of sending the information across a packet network (TCP/IP) to the requesting agency, (col. 3, lines 48-57). Dikmen, however, does not discuss in sufficient detail how information is formatted to be transmitted across the packet network such as with the use of bearer streams and bearer packets and having a Gateway Control Protocol that generates said bearer streams and packets.

Art Unit: 2645

In the same field of endeavor, Kung teaches of an IP based communication network for providing communication services for a subscriber and that it was well known in the art to use a Gateway Control Protocol instructions which instructs a generations of a duplicate bearer stream (col. 1, lines 42-59; col. 2, lines 50-63) and generating a duplicate of one or more bearer packets and control packets, (col. 1, lines 60-col. 2, lines 13), negotiating a secure IP link to the requesting agency; and transmitting one or more bearer packets and control packets to the requesting agency across a secure IP link (col. 1, line 60-col. 2, line 13; col. 3, lines 30-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Dikmen by transmitting the information across the packet network as described by Kung so that IP telephones can be monitored by a law enforcement agency.

Regarding claims 3 and 28, Dikmen, as applied to claim 1 and 27, teaches wherein the trigger event comprises one of a registration, a call connection, a call termination, and a service invocation, (col. 3, line 60 - col. 4, line 4).

Regarding claims 4 and 29, Dikmen, as applied to claim 3 and 28, teaches wherein the service invocation comprises a conference call, (col. 5, lines 46-63).

Regarding claims 5,19,23 and 26, Dikmen, as applied to claims 1,16,20 and 24 teaches wherein the access network comprises a radio access network, (col. 1, lines 27-29).

Regarding claims 18 and 22, Dikmen, as applied to claims 16 and 20, teaches wherein the call information comprises one of bearer data and call signaling data, (col. 6, lines 1-14).

Regarding claim 16, Dikmen teaches in a communication network providing communication services for a subscriber, (abstract), wherein the subscriber accesses the

Art Unit: 2645

communication network via an access network, and wherein a server operates in accordance with a computer program embodied on a computer-readable medium for providing surveillance within the communication network, (col.1, line 43-col. 2, line 2; col. 3, lines 5-34), the computer program comprising:

a first routine that directs the server to receive a request for surveillance services from a requesting agency, (col. 3, lines 60-63; subscribers that are lawfully authorized for initiating electronic surveillance will have a trigger in the network that will be initiated when a trigger event occurs);

a second routine that directs the server to receive trigger information associated with the subscriber, (col. 3, line 60-col. 4, line 4);

a third routine that, in response to the trigger information, directs the server to generate a duplicate of call information associated with the subscriber in response to the trigger information, col. 3, lines 18-22); and

a fourth routine that directs the server to transmit the duplicate of call information to the requesting agency, (col. 3, lines 18-34; col. 4, lines 62-67).

Dikmen further teaches of sending the information across a packet network (TCP/IP) to the requesting agency, (col. 3, lines 48-57). Dikmen, however, does not discuss in sufficient detail how information is formatted to be transmitted across the packet network such as with the use of bearer streams and bearer packets and having a Gateway Control Protocol that generates said bearer streams and packets.

In the same field of endeavor, Kung teaches of an IP based communication network for providing communication services for a subscriber and that it was well known in the art to use a

Gateway Control Protocol instructions which instructs a generations of a duplicate bearer stream (col. 1, lines 42-59; col. 2, lines 50-63) and generating a duplicate of one or more bearer packets and control packets, (col. 1, lines 60-col. 2, lines 13), negotiating a secure IP link to the requesting agency; and transmitting one or more bearer packets and control packets to the requesting agency across a secure IP link (col. 1, line 60-col. 2, line 13; col. 3, lines 30-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Dikmen by transmitting the information across the packet network as described by Kung so that IP telephones can be monitored by a law enforcement agency.

Regarding claims 20, 24 and 27, Dikmen teaches a method for providing surveillance within a communication network, (abstract), wherein the communication network providing communication services for a subscriber, (col. 1, line 43-col. 2, lines 5-34), and wherein the subscriber accesses the communication network via an access network and wherein a server operates in accordance with a computer program embodied on a computer-readable medium for providing surveillance within the communication network, (col. 1, lines 49-59; col. 3, lines 5-34), the method computer program comprising the steps of:

receiving a request for surveillance services from a requesting agency, (col. 3, lines 60-63);

dialoguing with an authentication authority to obtain information associated with the requested surveillance, (col. 3 lines 5-34);

receiving trigger information associated with surveillance services in response to a trigger event, (col. 3, lines 60-col. 4, line 4); and

Art Unit: 2645

transmitting a surveillance message to a core network in response to the trigger information, (col. 3, lines 18-22), the surveillance message including an instruction to convey a duplicate of call information associated with the subscriber, (col. 3, lines 18-22), wherein the core network generates and transmits the duplicate of call information to the requesting agency, (col. 4, lines 62-67).

Dikmen further teaches of sending the information across a packet network (TCP/IP) to the requesting agency, (col. 3, lines 48-57). Dikmen, however, does not discuss in sufficient detail how information is formatted to be transmitted across the packet network such as with the use of bearer streams and bearer packets and having a Gateway Control Protocol that generates said bearer streams and packets.

In the same field of endeavor, Kung teaches of an IP based communication network for providing communication services for a subscriber and that it was well known in the art to use a Gateway Control Protocol instructions which instructs a generations of a duplicate bearer stream (col. 1, lines 42-59; col. 2, lines 50-63) and generating a duplicate of one or more bearer packets and control packets, (col. 1, lines 60-col. 2, lines 13), negotiating a secure IP link to the requesting agency; and transmitting one or more bearer packets and control packets to the requesting agency across a secure IP link (col. 1, line 60-col. 2, line 13; col. 3, lines 30-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Dikmen by transmitting the information across the packet network as described by Kung so that IP telephones can be monitored by a law enforcement agency.

Art Unit: 2645

6. Claims 2, 17, 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dikmen in view of Kung and further in view of Bertacchi US Patent 5,930,698.

Regarding claims 2, 17, 21 and 25, while Dikmen, as applied to claims 1, 16, 20 and 24, teaches of trigger information associated with the surveillance services, Dikmen does not specifically teach wherein the trigger information associated with surveillance services comprises at least a requesting agency identifier nor does Dikmen teaches wherein the surveillance server is interfaced to an authentication authority element and the authentication authority element authenticates the request for surveillance services from the requesting agency.

Bertacchi teaches of a method for sending duplicate call information to a Law Enforcement Agency. Bertacchi further teaches of a trigger information associated with surveillance services comprising a requesting agency identifier (col. 1, lines 52-63) and wherein a surveillance server is interfaced to an authentication authority element and the authentication authority element authenticates the request for surveillance services form the requesting agency, (col. 1, lines 57-61; col. 4, lines 54-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Dikmen by including an agency identifier and an authentication authority for authenticating the request as taught by Bertacchi so that the system can verify whether the call can be lawfully monitored by the authorized agency.

Allowable Subject Matter

7. Claims 6-9, 12-15 are allowed.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fortman EP 1111892 A2 teaches of monitoring calls via an IP network.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 872-9306, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Art Unit: 2645

220 20th Street S.
Crystal Plaza two, Lobby, Room 1B03
Arlington, VA 22202

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 703-308-6262. The examiner can normally be reached on M-F (6:30AM - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OVIDIO ESCALANTE
PATENT EXAMINER



Ovidio Escalante
Examiner
Group 2645
December 20, 2004

O.E./oe



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600